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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/986,432 | 11/08/2001 | Seiji Umemoto | Q67173 | 5255 |

7590 12/15/2004
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

CURTIS, CRAIG

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2872

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/986,432 | Applicant(s) UMEMOTO, SEIJI | |
| | Examiner Craig Curtis | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/08/01, 08/09/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Disposition of the Instant Application

- This Office Action is responsive to Applicant's Remarks submitted on 28 September 2004, which have been made of record in the file.
- Claims 1-4 are presently pending in the instant application.

Claim Objections

1. Claims 1-4 are objected to because of the following informalities: The limitation "...is parallel with an absorption axis of said polarizing element... (emphasis added)" (recited in line 9 of claim 1) should be amended to read as follows: "...is parallel with the absorption axis of said polarizing element." Applicant need not be concerned that such amendment will violate the proper antecedent basis requirement of 35 U.S.C. §112, 2nd paragraph, because an absorptive polarizing element, by definition, inherently has an absorption axis. **Appropriate correction is required.**

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent Nos. 6,606,193 B2, 6,542,300 B2, and 6,667,787 B2.

With regard to the 6,606,193 B2 patent, although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between independent claim 1 of the instant invention and independent claim 1 of the '193 patent is that claim 1 of the instant invention requires that a slow axis of each of said retardation films be parallel with an [read: *the*] absorption axis of said polarizing element (emphasis added), whereas claim 1 of the '193 patent requires that a fast axis of said retardation films be parallel with an [read: *the*] absorption axis of said polarizing element (emphasis added). However, this distinction is not of a critical nature because orienting *either* the fast *or* the slow axes of said retardation films with *the* absorption axis of said polarizing element would have been an obvious design choice to one having ordinary skill in the polarization art, for at least the purpose of achieving a desired performance characteristic (e.g., contrast, etc.) of the resulting polarizer.

With regard to the 6,542,300 B2 patent, please refer to the comments made above regarding the obvious nature of the design choice regarding the orientation of either the fast or the slow axes of said retardation films with the absorption axis of said polarizing element; and with regard to the specific Nz ranges recited in the '300 patent, while this reference discloses the claimed invention but for explicit teachings of the specific Nz ranges recited in the claims of the instant invention (viz., $N_z = 0.15 - 0.35$ &

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Nz = 0.65 – 0.85), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of the **'300 patent** such that it exhibit the specific Nz ranges disclosed by the instant invention, for at least the purpose of achieving a desired performance characteristic (e.g., contrast, etc.) of the resulting polarizer, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955). This last argument, of course, can similarly be applied to reject the claims of the instant invention in light of the teachings of the **6,667,787 B2 patent**.

Response to Arguments

3. Applicant's arguments filed on 28 September 2004 with respect to claims 1-4 have been considered fully but have been rendered moot in view of the new ground(s) of rejection set forth hereinbefore.

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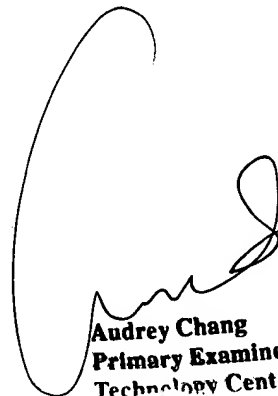
Contact Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Curtis, whose telephone number is (571) 272-2311. The examiner can normally be reached on Monday-Friday, 9:00 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C.H.C.
Craig H. Curtis
Group Art Unit 2872
6 December 2004



Audrey Chang
Primary Examiner
Technology Center 2800